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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/477,297	01/04/2000	JAMES R. TIGHE	062891.0381	9048
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BAKER & BOTTS LLP 2001 ROSS AVENUE DALLAS, TX 75201			EXAMINER BLOUNT, STEVEN	
			ART UNIT 2661	PAPER NUMBER

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/477,297

Applicant(s)

TIGHE ET AL.

Examiner

Steven Blount

Art Unit

2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4 - 11, 13 - 18, 20 - 21, and 24 - 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4 - 11, 13 - 18, 20 - 21, and 24 - 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4 - 5, 9, 10-11, 13, 16 - 18, 20 - 21, 24 - 25, 28 - 29, and 33 - 34 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. patent 6,449,269 to Edholm in view of U.S. patent 6,321,336 to Applegate et al.

Applicant is requested to refer to the rejection made in paper number 15 for a discussion of this rejection, as here it is being simply repeated.

3. Claims 6, 14, 26, and 31 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. patent 6,449,269 to Edholm and U.S. patent 6,321,336 to Applegate et al as applied above, and further in view of U.S. patent 5,896,379 to Haber.

Applicant is requested to refer to the rejection made in paper number 15 for a discussion of this rejection, as again it is here being simply repeated.

4. Claims 1, 4 - 5, 9 - 10, 11, 13, 16 - 18, 20 - 21, 24 - 25, 28 - 29, and 33 - 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,272,633 to Duke et al in view of U.S. patent 6,321,336 to Applegate et al.

With regard to claim 1, Duke et al teaches telephony intermediary 210, wherein 210 is an encoder (col 4 lines 2+) that has first and second ports (see the arrows entering and leaving the "box" 210) associated with the first and second telephony

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devices 110 and 150 (fig 1) wherein the payload is received by the intermediary and is encrypted (ie, it is manipulated - see box 230) and communicated to the second telephony device. Duke et al also mentions the fact that there are a limited number of types of secure telephone equipment in col 1, lines 40+. Duke et al does not however teach modifying the source address information associated with telecommunication data to specify the port of the virtual intermediary. This is taught in Applegate et al. See col 5, lines 55 to 60.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided an additional form of secure communication to Duke et al by hiding the source address, in light of the teachings of Applegate et al, in order to further secure the communication and prevent unauthorized reception of the conversation.

With regard to claim 4, see how IP is taught in both Applegate and Duke.

With regard to claim 5, see how UDP is taught in Duke in col 5.

With regard to claim 9, see col 7, lines 30+ of Applegate.

With regard to claim 10, see figure 5 of Applegate.

With regard to claims 11, 13, and 16 – 18, see the rejections above.

With regard to claim 20, see the session control block 364 in Applegate (fig 5).

With regard to claims 21, 24 – 25, and 28 – 29, each of these process steps are discussed in the rejection of the apparatus claims above.

5. Claims 6, 14, 26, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,272,633 to Duke et al in view of U.S. patent 6,321,336

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to Applegate et al as applied above, and further in view of U.S. patent 5,896,379 to Haber.

Duke/Applegate et al teach the invention as described above, but do not teach duplicating the data. This is taught in Haber. See col 1 lines 48+ and also col 7 lines 25+.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have duplicated the data of Duke/Applegate, in light of the teachings of Haber, in order to provide for the ability to broadcast a conversation to many end users.

6. Claims 7, 15, 27, 30, and 32 are rejected under 35 U.S.C. 103(a) as being obvious over either one of U.S. patent 6,272,633 to Duke et al, or U.S. patent 6,449,269 to Edholm in view of U.S. patent 6,321,336 to Applegate et al, and further in view of U.S. patent 6,002,689 to Christie et al.

(Duke et al or Edholm)/Applegate et al teach the invention as described above, but do not teach converting the data format so that it is compatible with a second telephony device.

Christie teaches a device that converts user communications from one format to another. See the abstract, lines 14+, and also col 20, lines 50+.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the intermediary of (Duke et al or Edholm)/Applegate et al with a protocol converter, in light of the teachings of Christie et al, in order to allow the participants in the conversation to converse over networks of different types.

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With regard to claim 30, see the above rejections, in addition to the fact that compression is taught in Duke and Edholm.

Response to Arguments

7. Applicant's arguments filed 8/26/04 have been fully considered but they are not persuasive.

The examiner agrees with the applicant that the motivation to combine the references may come from either the references themselves, or it may come from the knowledge available to one of (ordinary) skill in the art. "for purpose of combining references, those references need not explicitly suggest combining teachings, much less specific references" (In re Nilssen, 7 USPQ2d 1502 (1988)). The examiner disagrees with the applicant, however, regarding the assertion that Edholm and Appelgate are not properly combinable because "it must be obvious to combine the "address translation" steps of the claims with the "data manipulation" steps." (Remarks, page 14, last paragraph).

35 U.S.C. 103(a) states that:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such **that the subject matter as a whole** would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The applicant has disregarded whether the Edholm and Appellate references are properly combinable to meet the claimed invention as a whole, and is instead picking and choosing certain portions of the claim which he feels are particularly pertinent for discussion.

As noted previously, the examiner believes that there is ample motivation for

applying the secure server of Appelgate et al to the VOIP system taught in Edholm, and that one of ordinary skill in the art would have been motivated to do so in view of the fact the system provided by Appelgate et al (source address translation, and protection of user resources 170 and 100 in figure 1) would provide for a secure and private communication channel between the end users in Edholm et al. See the citation of In re Nilssen above, and note that it is well known in this art that the difficulty and desirability of providing secure communications in a VOIP system is a relevant problem.

Further, while the “data manipulation” steps of Edholm (echo cancellation and Compression), may not be specifically related to the security features of Appelgate which provide the primary motivation for combining these references, they are of themselves relevant to the combination in that the echo cancellation feature in Edholm (see col 8, lines 23+) would be desirable to use in a packet switching network such as that taught by *both* Edholm and Appelgate et al in order to suppress jitter and provide for a more pleasant (and perhaps even usable) conversation. A similar argument can be made for the compression feature, which would improve system efficiency by reducing the amount of data which must be processed.

The applicant argues that with respect to the combination of the Duke and Appelgate references, similar reasoning applies as that with respect to the Edholm and Appelgate references. To this extent, the examiners arguments above apply as well, except that the examiner believes, for the following reasons, the Duke/Appelgate combination more particularly addresses some of the applicants arguments.

Using the reasoning applied above, the proper basis for combining the Duke and Appelgate references is by considering their combined applicability to the elements of the claimed invention as a whole. However, even if one were allowed to pick out the address translation and data manipulation steps as suggested by the applicant, the examiner notes that the data manipulation step taught in Duke – encryption – is related to the address translation taught in Appelgate in that both are security related measures. Further, both would, in combination, provide multiple layers of security, a scheme well known in the art when communicating in insecure environments.

The applicant states that there is no motivation for using the Christie reference. The examiner disagrees, and notes the motivation provided in the rejection, second to last sub-paragraph of paragraph 8.

The applicant also states that elements 110 and 150 are not telephony devices. The examiner disagrees, noting that telephones are shown within boxes 110 and 1150.

Finally, applicant states that member 210 is not a “telephony intermediary”. The examiner again disagrees, noting that the word “intermediary” is a very broad one, and that member 210 is intermediate to member 110 and 250. Further, in the combination of references Duke et al/Appelgate, member 102 could also be considered to be an “intermediary.”

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to: (703) 872 – 9306

For formal communications, please mark "EXPEDITED PROCEDURE".

For informal or draft communications, please label "PROPOSED" or "DRAFT".

Any inquiry concerning this communication should be directed to Steven Blount whose telephone number is (571) 272 – 3071. Examiner Blount may be reached Monday through Friday between the hours of 9:00 to 5:30. If attempts to reach the Examiner are unsuccessful, the Examiner's Supervisor, Kenneth Vanderpuye, may be reached at (571) 272 – 3078.

SB 12/27/04




Ajit Patel
Primary Examiner